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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,226	02/13/2002	Naoya Yamato	219107US0	4816

22850 7590 08/16/2004

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1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KIM, VICKIE Y

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/073,226

Applicant(s)

YAMATO ET AL.

Examiner

Vickie Kim

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4,12-20,24,25 and 33-41.Claim(s) withdrawn from consideration: 5-11, 21-23, 26-32.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

**VICKIE KIM
PRIMARY EXAMINER**Vickie Kim
Primary Examiner
Art Unit: 1614

Continuation of 5. does NOT place the application in condition for allowance because: , firstly, the scope of the instant claims are embraced by the Hofrichter et al(US5591424) patent, see column 4, lines 45. For instance, the R3=C7-C10 is within preferred range(C6-C22) suggested by US'424. Secondly, the unexpected result that was tested with two specific species(i.e. decanoyl or ethylhexanoyl) can not be used to represent the sub-genus of the claimed invention. For example, the claims are not limited to dibutylamide but other derivatives having same n-acyl aminoacid amides or esters. Even if the superior gelling ability of those two species(i.e. decanoyl or ethylhexanoyl) is proven to be unexpected, the claim is still drawn to a compound not a gellant compound wherein applicant fails to claim his invention patentably distinct over the prior art of the record. For instance, any ordinary skilled artisan expect the claimed compounds (N-C7-C10 acyl glutamic acid dibutylamide) from US'424 teaching even though one would not preferred those than C12-C18's because of other reasons . In cosmetic or pharmaceutical industry, various factors are involved in or influence on manufacturing process. Even though one may not expect the best gelling ability but it has better hydrophilicity. Thus, for instance, one would have considered to extend the selection option(various compounds) to include C7-C10 to maximize the efficacy(e.g. cost reduction(carbon elongation may require more time and money), better hydrophilicity(easy accessibility and more selection for solvent, etc) and so on. One would have reasonable expect the C7-C10 glutamic acid dibutylamides with reasonable gelling ability that can be well used in patented invention. .